

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gary S. Henneberry

Serial No.: 10/714,006
Filed: November 14, 2003

Group Art Unit: 1732
Examiner: **M. Daniels**

For: DOUBLE-WALLED, BLOW-
MOLDED, POLY(VINYL
CHLORIDE) ARTICLE AND
METHOD OF MAKING SAME

VIA EFS-WEB Confirmation No.:
1954

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action, made final, mailed February 24, 2006, Assignee of Applicant requests a Pre-Appeal Brief Request for Review according to the procedures identified in the Patent and Trademark Office Notice of June 20, 2005.

§ 103 Rejections

The Office has failed to establish a prima facie obviousness rejection of the following claims using the following references because the Office has used impermissible hindsight reconstruction of the invention:

Claims 1, 4, and 5 in view of U.S. Pat. No. 3,372,429 (Kato);

Claims 2 and 3 in view of the asserted combination of Kato with U.S. Pat. No. 5,077,331 (Fahey et al.); and

I hereby certify that this paper is being transmitted by EFS-WEB to the United States Patent and Trademark Office on the date shown below:

Apr. 128, 2006
Date

Signed John H. Hornickel
John H. Hornickel, Reg. No. 29,393

Claim 4 in view of the asserted combination of Kato with the Irwin "Blow Molding" article

The error of the Office is the application of Patent '429 to Kato, as compared with Claim 1, reproduced here:

I. (Previously Presented) A method of making a double-walled poly(vinyl chloride)-containing article, comprising the steps of:

- (a) melting a composition containing poly(vinyl chloride);
- (b) continuously extruding the composition in the form of a parison, wherein the composition is made from a formulation having a 40 cm parison formation time of at least 40 seconds; and
- (c) blow molding the parison into a double-walled, blow-molded poly(vinyl chloride) article ranging in volume from about 22.5 in³ to about 4500 in³, where the longest dimension is at least 10 inches and the next longest dimension is at least 6 inches.

- There is nothing in Kato which describes, teaches, or suggests selection of a formulation **"having a 40 cm parison formation time of at least 40 seconds"**.
- There is nothing in Kato which describes, teaches, or suggest selection of **"a composition containing poly(vinyl chloride)"** from which one can continuously extrude 40 cm parison during at least 40 seconds.
- There is nothing in Kato which prescribes both the volume claimed in Claim 1 and a size **"where the longest dimension is at least 10 inches and the next longest dimension is at least 6 inches."**

The Office cites the Federal Circuit decision of *Gardner v. TEC Systems, Inc.* to prove that merely making the prior art product bigger is not patentable. The facts are more complicated than that. The Patent Office had allowed Claim 1 in suit "...over Vits, and that no reference shows more than does Vits." (220 USPQ 777, at 783).

"Differences between the prior art and the claimed invention therefore remain in the dimensional limitations recited in claim 1." (*Id.*) The case, as decided by Judge Rich, turned on whether the decision by the trial court judge was clearly erroneous. "The trial court would not have been clearly erroneous in concluding that the dimensional limitations did not specify a device which performed and operated any differently from the prior art. Its decision therefore stands." (220 USPQ 777, at 786)

What is learned from this precedent are the following points:

- The Office *can* allow claims with dimensional limitations over the prior art, if justified.
- Each decision on justification for allowance is fact-intensive.
- The inventor has opportunity to show unobviousness based on the law of Graham v. John Deere, which includes an assessment of secondary factors.

In *Gardner* the relevant prior art, Vits, was filed on September 21, 1961 and issued on May 4, 1965. The patent-in-suit was filed on September 23, 1963 and issued on July 1, 1969. **The claimed invention and the prior art were so contemporaneous that their respective pendencies in the Patent Office overlapped.**

In this situation, Kato was issued on March 12, 1968, **more than one-third of a century** before Applicant filed his provisional patent application, from which this application claims priority.

If moving from polyethylene to poly(vinyl chloride) was so obvious to one of ordinary skill in the art, why did it take 34 years before Applicant did so, and in a dimension never before tried by Kato or anyone else with poly(vinyl chloride).

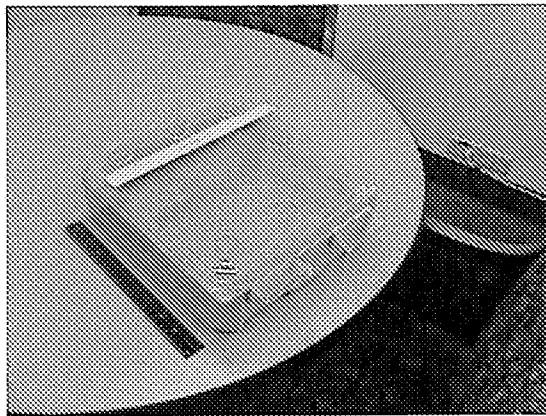
The secondary factors of Graham v. John Deere recognize "unsatisfied long felt need". Certainly a gap of **34 years** in the advance of the art of double-walled blow molding is sufficient evidence to rebut the allegation by the Office of prima facie obviousness. Applicant's claims are unobvious and patentable over Kato.

The sheer size of the double-walled, blow molding PVC articles made by the claimed process should not be brushed aside as mere differences in dimensions. In the real world of polymer engineering, there are many practical physical dimensional limitations. Would the Office be more impressed if the double-walled, blow molded article were the size of a house, even though all know that equipment is not so large as to produce an object that size? Where does the dimensional differences make a difference?

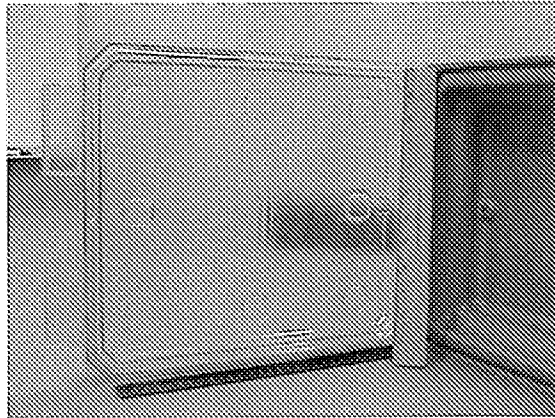
The fact that the Patent Office in the *Gardner* case DID ALLOW a claim over the prior art based on physical dimensional claim limitations proves Applicant's

point. There are significances, unobvious ones, that have blocked the art *for years*, 34 years to be exact in this instance. Applicant has broken through that barrier using a formulation satisfies the 40 cm (15 inches!) parison formation in 40 seconds, to produce a double-walled, blow-molded PVC article that has one dimension of at least 10 inches and another dimension of at least 6 inches. No small feat, and not obvious either.

To help the Office understand an embodiment of the invention, here are three images which show the double-walled, blow molded PVC article produced according to the claimed process, as measured using two 12 inch rulers. Both the clear lid and the gray box are made according to the invention, as explained in the specification beginning at page 9, line 28.



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Assignee of Applicant has rebutted the prima facie obviousness asserted by the Office, showing that the most pertinent prior art is 34 years old, with 34 years of unsatisfied need going unmet until Applicant came along, broke through real or imagined barriers and invented a method which literally looks over the prior art unexpectedly and patentably.

Applicant requests allowance of Claims 1-5 and will gladly accede to an Examiner's Amendment to cancel Claims 6-8 to permit the issuance of a Notice of Allowance.

If during the Pre-Appeal review, the panel would like further clarification, the panel is invited to contact the undersigned.

Date April 28, 2006

Respectfully submitted by:

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